

**REMARKS**

Applicants apologize for the confusion caused by the misnumbering of the claims. As explained in the Office Action on page 2, the Examiner considered original claims 30-63 to have been misnumbered and renumbered those claims as claims 29-62 and, furthermore, since there were two claims numbered "63," the first claim marked 63 was considered by the Examiner as claim 62, with the remaining claims numbered 63-66 unchanged. However, it is observed that there was an additional error in numbering in that two claims were numbered "28." By renumbering the second claim 28 as claim 29, each of originally numbered claims 30-63 are, in fact, correctly numbered. Consequently, the second claim that was originally numbered as claim 63 has been amended to read "claim 64," and the following claims have been renumbered accordingly. Entry of the amendments to correct the claim numbering is respectfully requested. Finally with regard to claim numbering, the Examiner's remarks have been interpreted in view of the renumbering used by the Examiner and the new numbers appearing in the present amendment have been cross-referenced. Again, Applicants apologize for the confusion caused by these errors.

Applicants affirm the election to prosecute the invention of Group I, claims 1-34 (now correctly numbered as claims 1-35), 39-43 (now correctly numbered 40-44) and 50-65 (now correctly numbered 51-66). In view of the Examiner's remarks regarding rejoinder of restricted process and product claims pursuant to MPEP §821.04, the claims withdrawn from further consideration as being drawn to a non-elected invention have not been canceled in order to provide for the opportunity to offer amendments consistent with the examined claims, if necessary; particularly claim 67 (corrected number), which identifies specific compounds.

Beginning on page 3 of the Office Action, the Examiner sets forth a requirement "to elect a single disclosed moiety" in various positions of the generic structure shown as Formula I in claim 1 "that is searchable for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable." The Examiner further advises "that a reply to this requirement must include a single moiety" in the various positions of the generic structure "and a listing of all claims readable thereon including any claims subsequently added." Finally the Examiner states that claims 39-43 (now correctly numbered 40-44) present a "multitude of compounds" and requires election of a single compound from the group of compounds presented in claims 1-34, 39-43 and 50-65" (in other words, Group I of the restricted claims, now correctly numbered as claims 1-35, 40-44 and 51-66). As support for this requirement, the Examiner cites 35 U.S.C. §121. These requirements are confusing.

Whereas an "election of species" requirement is normally stated as such and also refers to 35 U.S.C. §121, the quoted statements from the Office Action very carefully avoid the use of the phrase "election of species." This distinction is not explained and it is not clear why the Examiner has done so. Additionally, the Examiner does not refer to a specific section of the MPEP in support of the requirements set forth in the Office Action. However, in an effort to progress examination of the application Applicants can identify a compound that will facilitate searching; specifically, the third compound in the right-hand column on page 647 of the application as originally filed, said compound appearing in claim 40 (corrected claim number). Identification of a single compound for purposes of searching necessarily results in the presence of single moieties for each of positions A, E, G, J, L, M, Q, W, Y,

Z, R1, R2, R3 and R4 as shown in Formula I of claim 1. Other claims readable thereon include those claims that depend, either directly or indirectly, from claim 40, including correctly numbered claims 1-4, 7-14, 17, 25-27, 29, 41-44, 54, 63-66, and new claims 72,73, and 90-93 (all ranges inclusive of the numbers recited). By identifying a compound and claims Applicants do not suggest that their invention is limited to same and reserve the right to further prosecute the subject matter of all of the claims as originally filed and subsequently amended in this or a continuing application, since they are not being abandoned.

On page 7 of the Office Action, the Examiner refers to, and acknowledges, the priorities claimed in the present application. Although not explicitly stated, it appears that the Examiner notes that in claiming priority in the first paragraph of the present application, Applicants failed to recite the specific relationship of the present application to the prior application from which it depends. The instant amendment of that paragraph has been made in order to recite that the present application is a "continuation-in-part of the prior co-pending application, U.S. Serial Number 09/908,955. Entry of the amendment is respectfully requested.

Although not objected to, claim 2 has been amended to correct an apparent, inadvertent, editorial error in that the word "or" was left out of the claim in the recitation of alternative groups. Entry of the amendment is respectfully requested.

Claims 30 (corrected number 31), 33 (corrected number 34), 39-40 (corrected numbers 40-41), 42 (corrected number 43), 51-60 (corrected numbers 52-60) and 63 (corrected number 65) have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. These claims have been amended pursuant to

the Examiner's remarks appearing on page 8 of the Official Action.

Specifically, in claims 34 and 65, the phrase "still additionally" has been replaced by the word "further" so that the awkward phrase now reads, "further containing."

As suggested by the Examiner, claims 31, 40-41 and 52-61, as well as claims 36, 38 and 62, have been amended so that, prior to the first use of the abbreviation "HCV," there is the phrase "hepatitis C virus." Additionally, method claims 36, 38, 39, 45, and 62 have similarly been amended in order to be consistent with the amendments to the compound claims. While the abbreviation can be clearly understood from the whole of the application, the amendment is offered as a convenience to the reader.

In claims 42 (corrected number 43) and 63 (corrected number 65), have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that in claims 42 and 63, "PEG" needs to be spelled out in the first instance of use. The acronym "PEG" has been amended to "pegylated," as it is understood by one skilled in the art and in view of the disclosure in the application. Applicants refer to "PEG-interferon alpha conjugates" as interferon alpha molecules covalently attached to a "PEG" molecule (application page 94, starting at line 5). Furthermore, Applicants provide illustrative examples of such materials identified by trade names in the remainder of the identified paragraph. These materials are understood by those skilled in the art to represent the result of a process that attaches a polyethylene glycol (commonly known as PEG) molecule to a compound as recited, and are therefore known in the art as "pegylated" compounds. Entry of the amendment and withdrawal of this rejection is respectfully requested.

The Examiner further rejects claims 63 and 66 under 35 U.S.C. §112 on the basis that "a large blank space exists between the written segment of the claim and the segments of the claim that provides the chemical structures of the compounds of the invention." It is noted that the spaces are a consequence of printing, margins and grouping of the structures; this will likely change depending on the printing format used. However, in order to account for such variations, Applicants have reformatted the chemical structures so that each one is a separate image, allowing for greater flexibility of printing.

Entry of the amendments is respectfully requested. Withdrawal of the rejection of these claims under 35 U.S.C. § 112, second paragraph, is respectfully requested in view of these amendments.

Claim 30 (corrected number 31) is rejected under 35 U.S.C. § 101. The Examiner states that claim 31 provides for the use of a pharmaceutical composition, but the claim does not set forth any steps involved in a method or process. Furthermore, the Examiner states that insofar as the claim is a composition claim, the recited process ("use") does not *per se* modify the composition and therefore has no patentable weight. This rejection is traversed.

Claim 31 has been amended to include the word "suitable," which results in the phrase "suitable for." Consequently, the claim requires the claimed compositions "so perform" or not meet the terms of the claim. Therefore, the phrase constitutes a patentable limitation. In this regard, the Examiner's attention is invited to the decision in *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 9890, 54 U.S.P.Q.2d 1227 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1183 (2001). In that case, the patent's 41 claims to gasoline compositions that reduced automobile tail pipe emissions were

held not anticipated by prior art specialty fuel compositions, such as racing and aviation fuels. All of the claims began with either the phrase "[a]n unleaded gasoline *suitable for* combustion in an automotive engine" (emphasis added) or the phrase "[a]n unleaded gasoline fuel *suitable for* combustion in a spark ignition automotive engine" (emphasis added). The Federal Circuit held that the district court correctly interpreted the claims as limited to "mass market automotive gasoline." In other words, contrary to the Examiner's view in the present application, the phrase "suitable for" was interpreted in the context of the claim as having patentable significance in conjunction with the other terms of the claim. Respectfully, the same circumstances apply herein. Additionally, in *In re Watson*, 517 F.2d 465(1), 476(2)-477, 186 U.S.P.Q. 11(3), 20 (C.C.P.A. 1975), the court concluded that the claim phrase "an effective amount of a germicide *suitable for* use in oral hygiene" is not indefinite. *Id.* (emphasis added). Although the court directed its attention to the amount of a germicide, there was no objection to the use of the phrase "suitable for" in the claim. Withdrawal of this rejection is respectfully requested.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 00/05245, *Brunck et al.* (hereinafter "*Brunck*"). The Examiner relies on the disclosures at page 33, line 12 to page 43, line 7 and claim 1, pages 159-167 and the chemical structure shown in the Official Action at page 8. The Examiner then recites several of the generic components in claim 1 and claim 2 of the present application and selects various specific components for these generic components in order to arrive at the *Brunck* structure illustrated in the Office Action. It is noted that although the Examiner comments that R<sup>5</sup> may be "OH", the illustrated structure shows R<sup>5</sup> as "H." Overall, this rejection is traversed.

The disclosures of *Brunck* referred to in the Office Action are generic disclosures, not disclosures of specific compounds allegedly within the scope of instant claims 1 and 2. However, such picking and choosing is not appropriate in a 35 U.S.C. § 102 analysis. See, e.g., *In re Arkey, Eardly, and Long*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972):

"Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the 'prior art'" "... the [r]eference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings in the cited references. Such picking and choosing may be entirely proper when making a rejection of a 103, obviousness rejection, where the applicant must be afforded opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior but it has no place in the making of a 102, anticipation rejection."

(emphasis in the original).

Overlap of the genus taught in the reference and the genus of instant claims 1 and 2 is not sufficient to establish anticipation. Furthermore, *Brunck* is directed to subject matter that differs significantly from that of the present invention. Specifically, the reference is directed to compounds that inhibit blood vessel formation, whereas the presently claimed compounds treat hepatitis C virus. Consequently, there is no motivation in *Brunck* to make the selections suggested by the Examiner to arrive at the allegedly overlapping compounds,

absent Applicants' own teachings. It is respectfully suggested that the rejection is incorrect and should be withdrawn.

However, the dehydropolyol-containing compounds shown on pages 115 and 144-146 of the reference do appear to be within the scope of instant claims 1 and/or 2. Consequently, claim 1 has been amended to exclude these compounds from the scope of the instant claims by amending the recitation in the definition of generic component A to delete the recitation of "a bond." Withdrawal of this rejection and allowance of these claims is respectfully requested in view of the amendment and remarks.

A provisional double patenting rejection of claims 1-34 (corrected numbers 1-35, 40-44, and 51-66) under 35 U.S.C. §101 has been entered in view of copending Application No. 09/908955. As this is a provisional rejection, Applicant will address it when allowed claims so require. In particular, the Examiner states that the compounds in claim 39 (corrected number 40) of the present application (pages 631 to 665) are identical to compounds in claim 39 of copending Application No. 09/908955. It is respectfully noted that the two claims are not identical. In this regard the Examiner's attention is invited to the compounds starting at the end of claim 40 in the present application; the final 95 compounds included in claim 40 find no correspondence in claim 39 of the copending application.

Each of the new claims is directed to compounds disclosed in the application as filed. It is noted that Applicants have explicitly included stereoisomers and enantiomers as within the subject matter of their invention as stated in original claims 1 and 40 as well as in the claims from which the new claims depend, and in the specification at page 7, "Summary of the Invention," and on page 94 in the paragraph beginning at line 16. Entry and consideration of the new claims is respectfully requested.



As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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